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S.F.W.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Ernesto E. BLANCO

SERIAL NO: 10/092,560

GROUP: 3767

FILED: March 8, 2002

EXAMINER: HAN, MARK K.

FOR: SAFETY TROCAR WITH PROGRESSIVE CUTTING TIP GUARDS AND
GAS JET TISSUE DEFLECTOR

LETTER

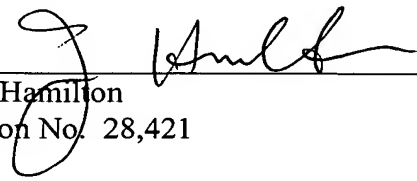
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is an European Office Action for the Examiner's consideration. The references cited therein have been previously filed on August 23, 2003, February 6, 2006 and September 13, 2006.

Respectfully Submitted,

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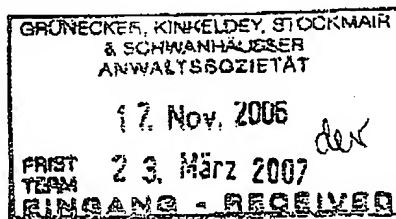
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H0058

Application No. 00 943 020.8 - 1265	Ref. EP23185-065/kg	Date 13.11.2006
Applicant Blanco, Ernesto E.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 76(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Moers, Roelof
Primary Examiner
for the Examining Division

Enclosure(s): 4 page/s reasons (Form 2906)



Bescheid/Protokoll (Anlage)

Datum
Date 13.11.2006

Communication/Minutes (Annex)

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Notification/Procès-verbal (Annexe)

Anmelde-Nr.: 00 943 020.8
Application No.:
Demande n°:

Application documents:

Description, Pages

1-3, 5-8, 10, 12-15 as published
4, 9, 11 received on

20.12.2001 with letter of 29.06.2001

Claims, Numbers

1-32 received on

29.09.2006 with letter of 28.09.2006

Drawings, Figures

1, 6-11, 14-17 as published
2-5, 12, 13, 18-22 received on

23.03.2005 with letter of 22.03.2005

1. The lack of unity objection raised in the previous communication is maintained.

1.1 The common subject-matter of (previous) independent claims 1, 6, 21 and 43 (subject 1) and (previous) independent claim 9 (subject 2) is: a surgical device comprising a handle, a penetrator with a cutting tip, a distal tissue expander and a guard.

The common subject-matter of (previous) independent claims 1, 6, 21 and 43 (subject 1) and (previous) independent claim 19 (subject 3) is: a surgical device comprising a handle, a penetrator with a cutting tip, a distal tissue expander and a guard.

1.2 This common subject-matter is known in the prior art, see for instance **US-A-5538509** (D3) which discloses (see figs. 8 and 10): a surgical device comprising a handle 20, a penetrator 18 with a cutting tip 17, a tissue expander 61, 63, 65 at a distal end of the penetrator (see col. 11, lines 30-43, surfaces 61, 63 and 65 act as tissue expanders) and a guard 52, 54, 56.

1.3 Nowhere in the original claims nor in the present claims is it clear that the cutting tip and the tissue expander are two separate elements.

1.4 Therefore, these common features cannot form "special technical features" according to Rule 30 EPC.

D3 also discloses the features of (previous) independent claims 16 and 18.

Filed on
2/6/06



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- 1.5 The possible "special technical features" of the first subject are formed by the fact that the device further comprises an insufflation passageway.
The possible "special technical features" of the second subject are formed by the fact that the guard progressively covers the tip.
The possible "special technical features" of the third subject are formed by the fact that the device further comprises at least one side horn.

Since these features are different and they solve different problems, there was a case of non-unity.

2. Since it is not clear from present claim 1 that the tissue expander 4 and the cutting tip 14b are two separate elements, the present application does not meet the requirements of Article 52(1) EPC. The subject-matter of claims 1-32 is either not new in the sense of Article 54(1) and (2) EPC or does not involve an inventive step in the sense of Article 56 EPC.

- 2.1 Document **US-A-5538509 (D3)** discloses (see figs. 8 and 10):

A surgical device, comprising:

a handle 20 configured to be gripped;

a penetrator 18 having a main axis and attached to said handle 20

a cutting tip 17 located at a distal end of said penetrator 18 (see fig. 10);

a guard 52, 54, 56 being configured to selectively expose said cutting tip 17, further comprising

a tissue expander 61, 63, 65 configured to expand a tissue cut by said cutting tip 17 for insertion of said penetrator 18; and wherein

said guard 52, 54, 56 is movable with respect to said tissue expander 61, 63, 65.

Thus, D3 discloses all the features of claim 1, taking away its novelty.

- 2.2 A similar objection can be made in view of **US-A-5454791 (D2)**, which discloses (see fig. 8):

A surgical device, comprising:

a handle 128 configured to be gripped;

a penetrator 112 having a main axis and attached to said handle 128



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a cutting tip located at a distal end of said penetrator 112 (distal point of part 144);
a guard 110 being configured to selectively expose said cutting tip,
further comprising
a tissue expander (conical sides of part 144) configured to expand a tissue cut by said
cutting tip (distal point of part 144) for insertion of said penetrator 112; and wherein
said guard 110 is movable with respect to said tissue expander (conical sides of part
144).

2.3 Dependent claims 2-32 do not appear to contain any additional features which, in
combination with the features of any claim to which they refer, meet the requirements of
the EPC with respect to novelty and/or inventive step:

- claim 2: see D3;
- claim 3: see **EP-A-769278 (D4)**, *Filed 9/13/2006*
- claims 4-14: alternative probe/tip designs;
- claims 15-22: insufflation passageways and seals are well known features for trocars;
- claims 23-27, 29-32: see D3;
- claim 28: see D2.

3. At present it would seem that the only possibility to come to an allowable claim would be
to include in present claim 1 that:

the cutting tip comprises pointed flat knives 14 joined at the center of the instrument and
resembling thin arrowheads joined at a center; and that
the penetrator 13 comprises a hollow cylinder 13 having its distal end formed as a
plurality of conical segment expanders 4 which are spaced by slots 4a to allow for the
protrusion of pointed flat knives 14 of the cutting tip. *Filed 8/29/2003*

3.1 Such a cutting tip is known from **US-A-4601710 (D5)**. This document also discloses a
hollow cylinder 30 having at its distal end a plurality of conical segments 38 which are
spaced by slots but this cylinder is the guard and is moveable relative to the cutting tip.

4. The applicant is invited to file new claims which take account of the above comments.



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Demande n°: